

Remarks

Claims 1, 3-13 are pending. Applicants have amended claims 10 and 13 herein.

Claims 10-13 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade et al. (U.S. Pat. No. 5,550,735) in view of Foresman et al. (U.S. Pat. No. 5,099,422).

Applicants respectfully traverse the rejections and request reconsideration based on the amendments and remarks made herein.

Rejections under 35 U.S.C. 101

Claims 10-13 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Applicants respectfully traverse the rejection; however to advance prosecution, Applicants have amended claims 10 and 13. Applicants respectfully submit that the claimed subject matter is positively tied to a particular machine and a transformation occurs at least in the steps of “assembling said personalized advertisement using said advertisement template and said selected media segments” and “providing said assembly personalized advertisement in a format for delivery to said intended audience for viewing.” Claim 10, 13; see also *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385, 1397 (Fed. Cir. 2008) (electronic transformation of data into a visual depiction is sufficient). Thus, Applicants respectfully submit that claims 10 and 13 positively recite patentable subject matter and therefore satisfy the requirements of 35 U.S.C. § 101. Further dependent claims 11 and 12, by virtue of their dependence on a proper base claims, include patentable subject matter.

Rejections under 35 U.S.C. 103(a)

Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade et al. (U.S. Pat. No. 5,550,735) in view of Foresman et al. (U.S. Pat. No. 5,099,422). Applicants respectfully state that one skilled in the art would not combine the cited teachings of Slade and Foresman because neither Slade nor Foresman disclose or teach, separately or in combination, each of the elements of Applicants' claims as arranged in the claims.

Slade

Slade discloses a system for the mass production and reproduction of customized presentation videotapes. High volume production is realized by matrixing synchronized system resources, such as videodisc players, videocassette recorders, and graphic generator units. Each tape is produced based on end-user selection of music or media selections.

Foresman

Foresman discloses a compiling system and method to enable the recording of individually customized information onto blank storage media devices, and includes a data base memory device for storing information signals indicative of customized recipient information pertaining to a group of recipients.

Applicants' Claims

Embodiments of the Applicants' invention include a system for dynamically constructing a non-interactive personalized advertisement to be viewed by an intended audience. An advertisement template defines a framework for constructing the personalized advertisement and

the advertisement template includes a plurality of media segment slots constituting the personalized advertisement. The media segment slots include video segment slots and audio segment slots where at least one video segment slot overlaps at least one audio segment slot. A plurality of media segments include video segments and audio segments where each video segment is selectable for insertion into at least one of the video segment slots of the advertisement template. Several of the video segments are selectable for a video segment slots of the advertisement template and each audio segment is selectable for insertion into at least one of the audio segment slots of the advertisement template. The system further includes a plurality of expert rules and an advertisement assembly component responsive to use profile data of the intended audience. The assembly component is configured to apply the plurality of expert rules to the user profile data in order to get the appropriate media segments for each of the media segment slots of the advertisement template from a database and incorporate the appropriate media segments into the advertisement template in order to assemble the personalized advertisement for the intended audience. The assembly is performed without interaction by the intended audience.

Response to Rejections

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. MPEP § 2141. If the Examiner does not produce a prima facie case, Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142. Applicants respectfully submit that the Office action makes conclusory statements and fails to provide any objective evidence from the prior art or elsewhere that shows the inventive subject matter recited in independent claims 1, 10 and 13 would be obvious to a person having ordinary skill in the art.

Applicants respectfully submit that the Office action does not set forth a prima facie case, and that independent claims 1, 10 and 13 would not have been obvious to a person having ordinary skill in the art.

As the Office action admits, Slade fails to disclose “the plurality of expert rules and of an advertisement assembly component which uses those rules in order to get appropriate media segments for each of said media segment slots of said advertisement.” To cure this deficiency, the Office action cites to Foresman’s teaching of a computer program having algorithms embodying formulae or rules to determine which recipient receives which information segments.

Applicants respectfully state that the combination of Slade and Foresman is improper because there is no need for a set of rules or formulae as articulated in Slade. Slade teaches a system for the mass production of pre-determined customized videotapes. According to Slade, “raw data 201 stored in the database memory of the data pre-processor 36 is retrieved and reassembled as processed data 203 **as determined by end user requirements**”. Slade, col. 5, ll 54-57 (emphasis added). The system of Slade is designed for end-user interaction to select the contents of the videotape. “Each medium device contains pre-recorded information segments, such as music video segments, **selected by an end user recipient**. Such a customized storage media can be utilized by the end user recipient, on widely available conventional videocassette players, audio cassette players, and other such devices. Slade, col. 2, ll. 51-56 (emphasis added).

Because the Slade disclosure relies upon the user-interaction and selection of media content, there is no need for a rule set as claimed by Applicants. There is no discussion of a need for a rule set, nor would the inclusion of a rule set provide the Slade invention with any advantage. As there is no need, or motivation, for a set of rules, clearly one skilled in the art would not combine the teachings of Slade to Foresman, or any other reference. In fact,

Applicants' independent claims specifically recite, "a non-interactive personalized advertisement" with "assembly performed without interaction by said intended audience." (See Claims 1, 10 and 13). The teachings of Slade include and even rely upon the interaction of an end-user to select appropriate media to be included on the customized videotape.

Based on the foregoing, Applicants submit that the combination of Slade and Foresman is improper, and in any event would still require end-user interaction; something specifically forbidden by independent claims 1, 10 and 13. Applicants submit that independent claims 1, 10 and 13 are patentably distinct from the cited references and are in condition for allowance. Applicant further submits that dependent claims 3-9 and 11-12, by virtue of their dependence on allowable base claims are also in condition for allowance.

CONCLUSION

For at least the reasons outlined above, Applicants submits that this application is in condition for allowance and requests favorable action in the form of a Notice of Allowance. Please apply any charges or credits to Deposit Account No. 50-1721.

If, in the Examiner's opinion, a telephonic interview would expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,

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Reg. No. 54,146

Tel. No.: (617) 261-3100
Fax No.: (617) 261-3175

/George S. Haight IV/
George S. Haight IV
Attorney for Applicant(s)
K&L Gates LLP
State Street Financial Center
One Lincoln Street
Boston, Massachusetts 02111-2950